

REMARKS

Favorable reconsideration of this application, as presently amended and in light of the following discussion, is respectfully requested.

Claims 1, 11, 13-15, 18, 19, and 21-23 are pending in this case. Claim 20 is canceled, and Claims 1, 13, 14, and 18 are amended and Claim 23 is added with support in the originally filed disclosure at least at paragraphs[0021], [0041] to [0045] and [0050]. Thus, no new matter is added.

The outstanding Office Action rejected Claims 1, 11, 13-15, and 18-22 under 35 U.S.C. § 102(b) as anticipated by Hikata (JP 07-094193) and, alternatively, under 35 U.S.C. § 103(a) as unpatentable over Hikata.

At the outset, Applicants and Applicants' representative thank Supervisory Patent Examiner Dah-Wei and Examiner Davis for the courtesy of a telephone interview on May 19, 2010. Proposed amendments were discussed during the interview, and some of the amendments are included herein.

In view of the cancelation of Claim 20, the rejections of that claim are moot.

The outstanding Office Action maintains that Hikata teaches the same material composition as claimed and, thus, inherently anticipates the claimed active material. With regard to the claimed average grain diameter, Hikata does not describe the claimed values, but the outstanding Office Action relies on MPEP § 2112.01(II) to assert that a composition and its properties are inseparable.

MPEP § 2112.01(II) states that products of identical chemical composition cannot have mutually exclusive properties. In the case discussed by MPEP § 2112.01(II), the Federal Circuit noted that pressure-sensitive adhesion was an inherent property not shown by the Applicant as lacking in the reference. In re Spada, 911 F.2d 705 (Fed. Cir. 1990).

However, the claimed average grain diameter of a zinc sheet or zinc can active material is not an inherent property at all. One of ordinary skill in the relevant art understands average grain diameter to be controllable based on numerous conditions, with the claimed temperature being one of those conditions, rather than being based solely on the presence of certain materials.

Further, Applicants submit, herewith, photographs obtained by metallurgical microscope. Fig. A (Hikata) shows coarse particle diameter in the range of 500-1000 μm for a container processed by a conventional can or sheet as in Hikata. On the other hand, Fig. B shows no such coarse particles for a container processed by a can or sheet of the claimed invention.

That is, Claim 1 is not directed to a compound of “zinc for major substance without lead virtually; and...0.1 percent by mass or more and 0.8 percent by mass or less of bismuth.” Instead, Claim 1 is directed to an active material for a manganese battery anode that comprises these elements. As such, the claimed average grain diameter cannot properly be asserted as being an inherent feature of any compound that includes “zinc for major substance without lead virtually; and...0.1 percent by mass or more and 0.8 percent by mass or less of bismuth.” Instead, the claimed average grain diameter is specific to the claimed active material, which is patentably distinct from the active material of Hikata.

Because Hikata does not anticipate or establish a *prima facie* case of obviousness against Claim 1, as discussed above, Applicants respectfully request that the rejections under 35 U.S.C. §§ 102(b) and 103(a) of Claim 1 and Claims 11 and 13-15, which depend therefrom, be withdrawn.

Claim 18, though differing in scope from Claim 1, patentably defines over Hikata at least for reasons that are similar to those discussed above with regard to Claim 1.

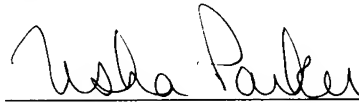
Thus, Applicants respectfully request that the rejections under 35 U.S.C. §§ 102(b) and 103(a) of Claim 18 and Claims 19, 21, and 22, which depend therefrom, be withdrawn.

New Claim 23 depends from Claim 1 and, therefore, patentably defines over Hikata for at least the same reasons as Claim 1.

Accordingly, the outstanding rejections are traversed and the pending claims are believed to be in condition for formal allowance. An early and favorable action to that effect is, therefore, respectfully requested.

Respectfully submitted,

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